

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

AF/3762
ZFW

Applicant: Bruce Tockman et al.

Title: LEAD HAVING VARYING STIFFNESS AND METHOD OF MANUFACTURING
THEREOF

Docket No.: 279.246US1

Filed: August 1, 2000

Examiner: George R. Evanisko



Serial No.: 09/630,000

Due Date: February 16, 2005

Group Art Unit: 3762

Mail Stop Appeal Brief--Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450


We are transmitting herewith the following attached items (as indicated with an "X"):

- ☒ Reply Brief Under 37 C.F.R. § 41.41 (10 pgs.).
- ☒ Copies of cited references (2) from attached Appendix I.
- ☒ A return postcard.

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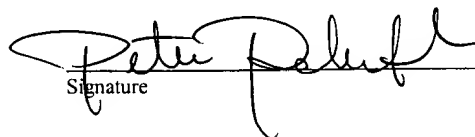
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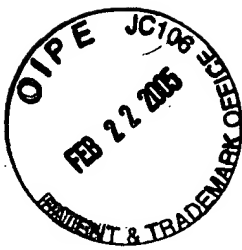
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PETER REBUFFONI

Name



Signature



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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For: LEAD HAVING VARYING STIFFNESS AND METHOD OF MANUFACTURING THEREFOR)		

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply is presented in response to the Examiner's Answer, dated December 16, 2004, which was sent in answer to Appellants' Appeal Brief, filed on October 15, 2004. Appellants' Appeal Brief was filed in response to the rejections of claims 16-26 and 43-46 of the above-identified application, as set forth in the Final Office Action mailed on March 17, 2004.

Please charge any required additional fees or credit overpayment to Deposit Account 19-0743.

1. REMARKS

The Examiner's Answer Brief, dated December 16, 2004, includes original grounds of rejection in the Final Office Action that are supplemented with new grounds of rejection in the Answer Brief. Appellants traverse the new grounds of rejection in the section "Argument in further discussion of the rejections of claims 16-26 and 43-46." Appellants respectfully maintain that the Appeal Brief, which is hereby incorporated by reference and reasserted in response, overcomes the original grounds of rejections.

Additionally, Appellants respectfully traverse the statement in the Answer Brief at page 2, paragraph 7, "Grouping of Claims," "The rejection of claims 16-26 and 43-46 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof." Appellants note that the requirement for showing claim groupings has been eliminated according to 37 C.F.R. § 41.37. See 37 C.F.R. § 41.37, enacted September 14, 2004. See also, Federal Register, Vol. 69, No. 155, August 12, 2004, Supplementary Information: Explanation of Changes, "Section 41.37 is added to generally incorporate the requirements of former Rule 192. In addition, the following changes have been made: . . . (9) The grouping of claims requirement set forth in former Rule 192(c)(7) is removed."

Appellants acknowledge the withdrawal of the 35 U.S.C. § 103 rejections in view of Nelson et al (6,249,708).

2. ARGUMENT IN FURTHER DISCUSSION OF THE REJECTIONS OF CLAIMS 16-26 AND 43-46

a. Claims 16-20, 24, 26, 43, 45 and 46 were improperly rejected under 35 U.S.C. 103 as being unpatentable over Cross, Jr. et al. (U.S. Patent No. 5,935,159), hereinafter Cross.

Appellants respectfully submit that the rejection of claims 16-20, 24, 26, 43, 45 and 46 under 35 U.S.C. 103 is improper. Reconsideration and allowance of claims 16-20, 24, 26, 43, 45 and 46 are respectfully requested.

i. The Rejection of Claims 16-20, 24, 43, 45 and 46 Fails to Establish a *Prima Facie* Case of Obviousness Because Cross Teaches Away From the Claims. The Answer Brief Fails to Rebut that Cross Teaches Away From the Claims.

As stated in the Appeal Brief, the rejection of claims 16-20, 24, 43, 45 and 46 fails because, among other reasons, Cross teaches away from the proposed modification. Prior art that teaches away from the claimed combination is a factor cutting against a finding of motivation to combine or modify the prior art. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, (Fed. Cir. 1994). Appellants submit Cross states at column 4, lines 40-45, “the core 102a takes the form of multiple sections 150, 152 and 154 which are structurally identical to one another, but are extruded of differing materials. For example, if a change in flexibility is desired along the length of the lead, core members fabricated of polyurethanes of differing hardness may be employed.” Cross teaches away from the proposed modification because Cross advises using extruded sections comprised of differing material that are separate from the conductors, and that are not the conductors, as opposed to the apparatus recited in claim 16 and incorporated in claims 17-20, 24, 43, 45 and 46 having individually insulated coradial conductors including a first conductor and a second conductor, the first conductor comprised of a first material, and the second conductor comprised of a second material, wherein the first material has a different stiffness than the second material.

Appellants respectfully submit the statements in the Answer Brief at, for example, page 3, last paragraph to page 4, first paragraph, fail to rebut that Cross teaches away

from the proposed modification. Appellants are unclear as to whether these statements constitute a new ground of rejection for claims 16-20, 24, 43, 45 and 46. For completeness of the Appeal, Appellants traverse the statements as a new ground of rejection and respectfully request clarification.

The Answer Brief fails to rebut that Cross teaches away from the proposed modification. The Answer Brief states, for example:

In addition, Cross states in column 2, line 52, to column 3, line 9, and shown in figures 3-6 and 12, that each conductor can be different conductors to accommodate different currents and incorporates by reference Shoberg et al (US Patent No. 5,584,873) and Laske et al (Patent No. 5,760,341). [See Appendix I]. It is noted that Laske et al discuss the use of different conductors of different material and different stiffness throughout his specification, and particularly in column 7, lines 34-43."

Answer Brief, page 3, last paragraph to page 4, first paragraph.

Appellants respectfully traverse the statement in the Answer Brief at page 3, last paragraph, "Cross states in column 2, line 52, to column 3, line 9, and shown in figures 3-6 and 12, that each conductor can be different conductors to accommodate different currents." Appellants respectfully submit, Cross states at column 2, lines 56-64, "Each of these conductors may take the form of a bundled, stranded conductor . . . The invention may also be practiced using any of the numerous other stranded conductors known to the art and may also be usefully practiced using coiled conductors." Appellants submit that Cross appears to describe conductor structures (i.e., bundled, stranded, coiled) as opposed to a first conductor and a second conductor, the first conductor comprised of a first material, and the second conductor comprised of a second material, wherein the first material has a different stiffness than the second material, as recited in claim 16 and incorporated in claims 17-20, 24, 43, 45 and 46.

Further, Appellants respectfully traverse the statement in the Answer Brief at page 4, first paragraph, "It is noted that Laske et al discuss the use of *different conductors of different materials* and different stiffness throughout his specification, and particularly in column 7, lines 34-43." (Emphasis added). Appellants respectfully submit Laske describes at column 3, lines 59-62, "a biomedical lead *conductor cable* formed of a core

wire strand and a plurality of outer or perimeter wire strands wrapped in a helical pattern around the core wire strand.” (Emphasis added). Appellants further submit Laske describes at column 4, lines 33-36, “Advantageously, the combination of materials for the *core wires and peripheral wires* of each wire strand provides a strong lead *conductor cable* with enhanced electrical conductivity.” (Emphasis added). The cited reference teaches away from the proposed modification because Laske advises using core wires and peripheral wires having different materials to form a *single conductor*, as opposed to the apparatus recited in claim 16 and incorporated in claims 17-20, 24, 43, 45 and 46 having a first conductor comprised of a first material, and a second conductor comprised of a second material, wherein the first material has a different stiffness than the second material.

Moreover, the Answer Brief provides conclusory and unsupported statements at page 7, second paragraph, that fail to rebut that Cross teaches away from the proposed modification:

Cross does not preclude the use of conductors having different stiffness. Stiffness can be provided to the lead in multiple ways, such as by using different materials for the lead body, different materials for the conductors, additional conductors in certain sections of the lead body, stiffening stylets or a combination of any of the preceding . . . Cross does not state this is the only way to provide different stiffness to the lead or that different conductors having different stiffness can not be used.

Answer Brief, page 7, second paragraph.

As stated in the Appeal Brief, Appellants respectfully disagree that a reference needs to preclude other avenues of performing a desired function in order to teach away from a proposed modification. Instead, a reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, (Fed. Cir. 1994).

Additionally, Appellants are unclear regarding the purpose of providing a conclusory listing of other avenues to perform a stiffening function in the Answer Brief. According to 35 U.S.C. § 132, “whenever, on examination, any claim for a patent is

rejected . . . the Director shall notify the applicant thereof, stating the reasons for such rejection . . . together with such information and references as may be useful in judging of the propriety of continuing the prosecution.” “Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.” *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990) citing *In re Wilke*, 314 F.2d 558, 562, (C.C.P.A. 1963). Appellants respectfully submit the Answer Brief statement at page 7, second paragraph, is uninformative and prevents Appellants from recognizing and countering the grounds of rejection. For example, the statement, “stiffness can be provided to the lead in multiple ways, such as by using different materials for the lead body,” appears to refer to statements in Cross at column 4, lines 40-45, and relied on by Appellants as evidence Cross teaches away from the proposed modification. Appellants are unclear regarding how this statement is applicable against Appellants’ position and therefore request clarification. Moreover, the Answer Brief fails to provide objective support for at least some of the avenues to perform a stiffening function (e.g., “different materials for the conductors, additional conductors in certain sections of the lead body, stiffening stylets or a combination of any of the preceding”, Answer Brief, page 7, second paragraph). To the extent the Answer Brief statements at page 7, second paragraph, are uninformative and prevent Appellants from recognizing and countering the grounds of rejection, Appellants respectfully traverse and request a fully developed rejection to properly respond to the assertions. Alternatively, Appellants respectfully request withdrawal of this line of argument.

As stated above, Appellants submit Cross (including Laske and Shoberg) teaches away from the proposed modification which cuts against a motivation to selectively modify Cross in the manner proposed. Therefore the rejection of claims 16-20, 24, 43, 45 and 46 fails to provide a *prima facie* case of obviousness.

ii. The Rejection of Claims 16-20, 24, 43, 45 and 46 Fails to Provide a *Prima Facie* Case of Obviousness Because There is No Objective Reason to Selectively Modify Cross. The Answer Brief Fails to Rebut the Lack of an Objective Reason to Selectively Modify Cross.

Appellants respectfully submit the Answer Brief statements at, for example, page 6, last paragraph, fail to rebut the lack of an objective reason to selectively modify Cross in the manner proposed. The Answer Brief merely recites patent numbers along with a cursory description of the patents, but fails to incorporate the recited patents in an objective fully developed rationale to selectively modify Cross.

The rejection of claims 16-20, 24, 43, 45 and 46 fails to state a *prima facie* case of obviousness because the Final Office Action and the Answer Brief do not identify a proper motivation to modify Cross in the manner proposed. The Final Office Action states at page 4, last paragraph to page 5, first paragraph, "It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lead as taught by Cross, with insulated conductors being different materials . . . since it was known in the art that leads are provided with insulated conductors being different materials, wherein the first material has a different stiffness than a second material to provide . . . different flexibility/stiffness to the lead." However, despite asserting that this was "known in the art" no objective reference was provided in the Final Office Action or the Answer Brief in a fully developed rejection under 35 USC § 103 establishing such an assertion. Instead, the Final Office Action merely states at page 6, paragraph 3, "the last office action [dated August 18, 2003] provided three teachings (US patents 6253111, 4640983, 6400992) that show the use of different conductors having different stiffness." The Answer Brief continues this line of argument and fails to identify a proper motivation to modify Cross in the manner proposed. The Answer Brief states, for example:

"The applicant asked for references in the amendment and remarks of 12/22/03 to support the obviousness rejection. Patent number 4,640,983 to Comte and patent number 6,400,992 to Borgersen et al were provided to show that it is obvious to use conductors of different materials and different stiffness to provide different and required impedance/resistances, different current carrying capabilities, and/or different flexibility/stiffness to the lead."

Answer Brief, page 6, second paragraph.

Appellants respectfully submit the statements at Answer Brief, page 6, last paragraph are conclusory and do not fully restate the Appellants' request for a fully developed rejection. According to M.P.E.P. § 707.07(g), "The Examiner should reject each claim on all valid grounds available . . . Where a major technical rejection is proper, it should be stated with a *full development* of reasons rather than by mere conclusion." (Emphasis added). Pursuant to M.P.E.P. § 707.07(g), Appellants requested in the Amendment and Response to the Final Office Action dated 5/17/2004 that "the Examiner provide a fully developed rejection or withdraw this line of argument." The request for a fully developed rejection was reiterated again in the Appeal Brief at page 15.

Without a fully developed rejection, Appellants respectfully submit the statements at page 6, paragraph 3 of the Final Office Action and at page 6, last paragraph of the Appeal Brief are conclusory arguments and do not appear to be reasoned as required by *In re Fine*, and therefore do not provide a proper rationale to modify Cross in the manner proposed. Furthermore, the assertions are not objective as required by *In re Lee*.

Further, the Final Office Action and the Answer Brief do not state how or why Cross would be in need of individually insulated coradial conductors including a first conductor and a second conductor, the first conductor comprised of a first material, and the second conductor comprised of a second material, wherein the first material has a different stiffness than the second material, as recited in claim 16 and incorporated in dependent claims 17-20, 24, 43, 45 and 46. Appellants cannot find any objective suggestion in Cross to employ such structure and therefore the rejection of claims 16-20, 24, 43, 45 and 46 fails to provide a *prima facie* case of obviousness.

3. SUMMARY AND REMARKS CONCERNING THE RESPONSE TO ARGUMENTS

The Final Office Action and the Answer Brief fail to establish a legally sufficient case of obviousness and Appellants respectfully traverse on several grounds as described above and in the Appeal Brief.

In light of the above, Appellants submit that when properly considered as a whole, and when the actual claim language is examined without hindsight reconstruction, the pending claims are patentable over the cited art. Reconsideration and allowance are respectfully requested.

Respectfully submitted,

BRUCE TOCKMAN ET AL.

By their Representatives,

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Date 2/16/05

By



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Peter Rehffoni
Name


Signature

APPENDIX I

Art of Record

I. Art of Record

U.S. 5,584,873 entered in the Answer Brief dated December 16, 2004.

U.S. 5,760,341 entered in the Answer Brief dated December 16, 2004.